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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,813	12/20/1999	MASATOSHI KUMAGAI	PM265486	1620

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EXAMINER

BLAIR, DOUGLAS B

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 08/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/466,813

Applicant(s)

KUMAGAI ET AL.

Examiner

Douglas B Blair

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).
3. Claim 24 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,014,502 to Moraes.
4. As to claim 24, Moraes teaches a web server for sending a predetermined program to a terminal based on a request from the terminal (col. 10, lines 43-64), comprising: a reception portion operable to receive a request to add advertisement information to a mail from the terminal (col. 5, lines 3-37, The member profile information is used to request certain types of advertisement.); and a setting controller operable to send a program to the terminal from which the adding request came so that setting for enabling a mail server that adds the advertisement information to the mail to send a mail to a mail address of a recipient, is performed (col. 10, lines 43-64).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,360,221 to Gough et al. in view of U.S. Patent Number 6,047,310 to Kamakura et al. and U.S. Patent Number 6,073,165 to Narasimhan et al..

7. As to claim 1, Gough teaches a server sending a mail having a predetermined mail address as a recipient to a server that receives and manages the mail having the predetermined mail address (col. 4, lines 1-21), comprising: an advertisement information adding portion operable to add the advertisement information to the mail (col. 7, lines 25-42); and a sending portion operable to send the mail to a user (col. 5, lines 28-39); however, Gough does not explicitly teach an advertisement information memory, an advertisement information detector, or the use of an SMTP server.

Kamakura teaches an advertisement information memory operable to store advertisement information to be added to the mail (col. 6, lines 13-36) and an advertisement information detector operable to detect the advertisement information to be added to a mail from the advertisement information memory based on at least one of user information about a user having the mail address of the recipient of the mail, user information about a user having a mail address of a sender of the mail and a sentence included in the mail (col. 4, lines 35-57).

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Narasimhan teaches the use of an SMTP server in a mail content filtering system (col. 3, lines 10-20).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gough regarding the addition of advertisements to electronic mail messages with the teachings of Kamakura regarding the use of information to user information to filter advertisements because both teach an email advertising system and a filtering mechanism could be added to Gough's embodiment without changing the functionality of the invention. It would have been further obvious to combine the teachings of Narasimhan regarding the use of an SMTP server with the teachings of both Gough and Kamakura because the use of an SMTP server would not alter the functionality of the previously discussed email advertising systems.

8. As to claim 2, Gough teaches a server wherein the advertisement information includes a page specifying information that specifies a predetermined homepage (col. 18, lines 40-43).

9. As to claim 3, Kamakura teaches a server wherein the user information includes attribute information that indicates an attribute of the user, a user information memory is further provided to be operable to store a plurality of mail addresses and a plurality of pieces of attribute information about users for the plurality of mail addresses so as to be associated with each other (Figure 11 shows a table that contains addresses and attributes.), respectively, and the advertisement information memory stores the advertisement information and attribute information about a user who is an object for which addition of said advertisement information is performed so as to be associated with each other, the advertisement information detector detects the attribute information associated with the mail address of the recipient of the mail from the

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user information memory, and detects the advertisement information associated with said detected attributed information from the advertisement memory (Figure 14 shows the processes used to distribute the advertisement.).

10. As to claim 4, Kamakura teaches a server wherein the attribute information is at least one of age, gender, and a zip code (col. 4, lines 49-57).

11. As to claim 5, Gough teaches a server comprising an addition refusal information memory, operable to store addition refusal information specifying a mail address that refuses the addition of the advertisement and an addition controller operable to stop the addition of the advertisement information by the advertisement information adding a portion to the mail, in a case where the mail address specified by the addition refusal information is the mail address of the recipient of the mail (col. 6, lines 12-39).

12. As to claim 10, Gough teaches a server sending a mail having a predetermined mail address as a recipient to a server that receives and manages the mail having the predetermined mail address (col. 4, lines 1-21), comprising: a mail memory operable to store the mail having the predetermined mail address as the recipient (col. 6, lines 12-39); an advertisement information adding portion operable to add the advertisement information to the mail (col. 7, lines 25-42); and a sending portion operable to send the mail to a user (col. 5, lines 28-39); however, Gough does not explicitly teach an advertisement information memory, an advertisement information detector, or the use of an POP server.

Kamakura teaches an advertisement information memory operable to store advertisement information to be added to the mail (col. 6, lines 13-36) and an advertisement information detector operable to detect the advertisement information to be added to a mail from the

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advertisement information memory based on at least one of user information about a user having the mail address of the recipient of the mail, user information about a user having a mail address of a sender of the mail and a sentence included in the mail (col. 4, lines 35-57).

Narasimhan teaches the use of a POP server in a mail content filtering system (col. 3, lines 10-20).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gough regarding the addition of advertisements to electronic mail messages with the teachings of Kamakura regarding the use of information to user information to filter advertisements because both teach an email advertising system and a filtering mechanism could be added to Gough's embodiment without changing the functionality of the invention. It would have been further obvious to combine the teachings of Narasimhan regarding the use of a POP server with the teachings of both Gough and Kamakura because the use of a POP server would not alter the functionality of the previously discussed email advertising systems.

13. As to claims 11-14, they have similar limitations to claims 2-5, respectively and are thus rejected on the same basis as claims 2-5.

14. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,360,221 to Gough et al. in view of U.S. Patent Number 6,047,310 to Kamakura et al. and U.S. Patent Number 6,073,165 to Narasimhan et al. as applied to claim 5 above, and further in view of U.S. Patent Number 6,128,646 to Miloslavsky.

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15. As to claim 6, the teachings of Gough, Kamakura, and Narasimhan combine to make the matter of claim 5 obvious; however, Gough, Kamakura, and Narasimhan do not explicitly mention the use of key words for filtering advertisements.

Miloslovsky teaches the idea of parsing emails in order to search for specific keywords and performing an action based on those keywords (col. 4, lines 11-64).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gough, Kamakura, and Narasimhan regarding a server for sending advertisements in email with the teachings of Miloslovsky regarding filtering based on keywords because sending advertisements based on keywords would provide more relevant advertisements for consumers.

16. As to claim 7, Miloslovsky teaches the idea of parsing emails in order to search for specific keywords and performing an action based on those keywords (col. 4, lines 11-64).

17. As to claim 8, Kamakura teaches a server wherein the mail has a plurality of mail addresses of recipients, the sending portion sends the mail to each of the mail addresses of the recipients when the mail has the plurality of mail addresses of the recipients (Figure 22), the advertisements information detector detects the advertisement information to be added to the mail that is to be sent to each of the mail addresses, based on the attribute information of the user corresponding to each of the mail addresses (col. 4, lines 35-57), and the advertisement information adding portion adds the advertisement information to the mail that is sent to each of the mail addresses of the recipients (Figure 21).

18. As to claim 9, Gough teaches a server comprising a point information memory operable to store a mail address and point information for a user having said mail address to be associated

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with each other; and a point updating portion operable to update the point information associated with the mail address of the sender of the mail, when the advertisement information adding portion adds the mail to the advertisement information (col. 15, lines 23-47).

19. As to claims 15-18, they have similar limitations to claims 6-9, respectively, and are thus rejected on the same basis as claims 6-9.

20. Claims 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,360,221 to Gough et al. in view of U.S. Patent Number 6,014,502 to Moraes and U.S. Patent Number 6,047,310 to Kamakura et al..

21. As to claim 19, Gough teaches a mail server operable to send a mail having a predetermined mail address as a recipient to a server that receives and stores the mail having the predetermined mail address as the recipient (col. 4, lines 1-21), wherein the mail server includes: an advertisement information adding portion operable to add the advertisement information to the mail (col. 7, lines 25-42); and a sending portion operable to send the mail to a user (col. 5, lines 28-39); however, Gough does not explicitly teach a system for sending a predetermined program to a terminal, an advertisement information memory, an advertisement information detector, a reception portion operable to receive an adding request of advertisement information to the mail from the terminal, or a setting controller.

Moreas teaches a mail processing system comprising a web server operable to send a predetermined program to a terminal based on a request from the terminal (col. 10, lines 43-64); a reception portion operable to receive an adding request of advertisement information to the mail from the terminal (col. 5, lines 3-37, The member profile information is used to request certain types of advertisement.); and a setting controller operable to make a setting for allowing

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the mail to be sent by the mail server, by sending a program to the terminal from which the adding request is received (col. 10, lines 43-64).

Kamakura teaches an advertisement information memory operable to store advertisement information added to the mail to be sent (col. 6, lines 13-36) and an advertisement information detector operable to retrieve the advertisement information from the advertisement information memory that is to be added to the mail (col. 4, lines 35-57).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Gough regarding the addition of advertisements to email with the teachings of Moraes regarding an advertising system with a downloaded program and the teachings of Kamakura regarding an advertising information detector because all three systems are methods of advertising through email so the combination of their features would be logical.

22. As to claim 20, Moraes teaches a mail processing system, wherein the advertisement information adding portion of the mail server adds to the mail, advertisement information including user specifying information that specifies a user of the mail, address of the recipient of the mail, and link information that makes the terminal used by the user send the user specifying information to the web server when an instruction by the user occurs (col. 10, lines 43-64), the web server or the mail server includes a point information memory operable to a mail address, and point information of a memory operable to a mail address, and point information of a user having said mail address to be associated with each other (col. 23, lines 34-47), the web server further includes: a user specifying information receiving portion operable to receive the user specifying information sent from the terminal by the link information sent from the terminal by

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the link information (Figure 6 shows user specifying information being sent from a client terminal to the server.); and a point updating portion operable to update, based on the user specifying information received by the user specifying information receiving portion, the point information of the corresponding user (col. 23, lines 24-47).

23. As to claim 21, Moraes teaches a mail processing system wherein the advertisement information adding portion in the mail server adds to the mail advertisement, specifying information that specifies an advertiser of the advertisement information, and link information that makes a terminal used by the user having the mail address of the recipient of the mail send the advertisement specifying information to the web server when an instruction of said user occurs (col. 10, lines 43-64), the web server or the mail server includes a charging information memory operable to store information specifying an advertiser and charging information about charging on said advertiser (col. 23, lines 24-47), the web server further includes: an advertisement specifying information receiving portion operable to receive the advertisement specifying information sent from the terminal by the link information (col. 20, lines 34-56); and a charging information updating portion operable to update based on the advertisement specifying information received by the advertisement specifying information receiving portion, the charging information of a corresponding advertiser (col. 20, lines 34-56).

24. As to claim 22, Moraes teaches a mail processing system wherein the web server or the mail server includes a charging information memory operable to store advertisement specifying information that specifies an advertiser, charging information about charging on said advertiser, and address information of an advertisement homepage to be presented to a user of a terminal (col. 6, lines 41-65), so as to be associated with one another, the advertisement information

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adding portion adds to the mail advertisement, specifying information that specifies an advertiser of the advertisement information, and link information that makes the terminal send the advertisement specifying information to the web server in a case where an instruction of the user of the terminal occurs (col. 10, lines 43-64), the web server includes: an advertisement specifying information receiving portion operable to receive the advertisement specifying information sent from the terminal by the link information (col. 20, lines 34-56); an instruction information memory controller operable to control the terminal that sent the advertisement specifying information, to store instruction information indicating that an instruction by the user occurred (col. 10, lines 43-64); however Moreas does not explicitly teach a homepage retrieval controller.

Gough teaches a homepage retrieval controller operable to detect, based on the advertisement specifying information received by the advertisement specifying information receiving portion, the address information of the advertisement homepage associated with the advertisement specifying information and to control the terminal to retrieve the advertisement homepage having said address information (col. 18, lines 40-43).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Moreas regarding an email advertisement system with the teachings of Gough regarding linking to a homepage in an email advertisement system because linking to a homepage would provide the user with more information about the advertiser, increasing the effectiveness of the advertisement.

25. As to claim 23, Moreas teaches a confirmation receiving portion operable to receive confirmation that the instruction information is stored in a terminal that requested a

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predetermined target homepage that is linked to the advertisement homepage (col. 6, lines 41-65); and a goal achievement charging updating portion operable to update, based on receipt of the confirmation, the charging information associated with an advertisement specifying information of an advertiser of the target homepage indicated by the confirmation (col. 6, lines 41-65).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B Blair whose telephone number is 703-305-5267. The examiner can normally be reached on 9am-6:30pm Mon-Thurs, alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (703)305-4815. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-4731 for regular communications and (703)305-4731 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Douglas Blair
August 5, 2002

DBB


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